

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Final Office Action mailed November 19, 2009. Claims 1-30 are pending, with claims 1-8 and 21-30 previously withdrawn from consideration. Claims 9-20 have been rejected. Applicants respectfully traverse all adverse assertions and rejections presented in the Final Office Action. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 103

Claims 9 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shortt (U.S. Patent No. 6,948,223) in view of Morales (U.S. Patent No. 5,920,975) and Hanson et al. (U.S. Patent No. 5,893,868), hereinafter Hanson. After careful review, Applicants must respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03).

In rejecting the claims, the Final Office Action acknowledges that “Shortt also fails to disclose a maximum outer diameter of the distal section of the balloon that is no greater than the initial diameter of the stent since the balloon includes a distal pillow.” Hanson is advanced as teaching that it is well known to include only a proximal pillow (resulting from dam 18), and the Response to Arguments states that “Hanson teaches that a single proximal pillow is able to keep the balloon in position”. While Hanson does appear to teach that a single proximal or distal “dam” may be provided to a stent-delivering balloon catheter, Shortt and Hanson (either alone or in combination) do not appear to provide for the conditions as recited in the claimed method. More specifically, the device of Shortt, the device of Hanson, and the device of Shortt modified to include only a single dam as taught by Hanson do not appear to provide “the maximum outer diameter of the distal section of the balloon uncovered by the stent is no greater than the initial outer diameter of the stent” when the balloon is inflated inside of the stepped enclosure with the distal end of the balloon uncovered by the crimped stent, as in pending

claim 9. The balloon of Shortt, when inflated, produces both a proximal and a distal pillow. The balloon of Shortt, modified with a proximal “dam” and no distal “dam” as taught by Hanson, does not prevent the distal pillow from forming as it would in the unmodified Shortt balloon. Further, neither Shortt nor Hanson appear to teach restraining the distal portion of the balloon in any way that would prevent a distal pillow from forming when inflated under the conditions of the claim. Thus, one skilled in the art will realize that the balloon shown in Figure 16 of Hanson, if inflated within a stepped enclosure disposed over the stent and the balloon as specified by the claim, would still provide a distal pillow. The distal pillow may not be supported by a distal “dam” as in Figure 18 of Hanson, but a pillow would still form due to the nature of a balloon, as evidenced by Shortt.

Accordingly, the proposed combination of Shortt, Morales, and Hanson cannot be considered as disclosing each and every element of the claimed method, as is required to establish a *prima facie* rejection. Applicants submit that independent claim 9 is therefore patentable over the proposed combination. Since claim 13 depends therefrom and adds additional elements thereto, Applicants submit that claim 13 is also patentable over the cited combination. Withdrawal of the rejection is respectfully requested.

Furthermore, while appreciating that the above rejection is based upon unidentified prior art, Applicants note that the prior art process expressly disclosed by Shortt does not appear to be operable. While one of ordinary skill in the art might understand that “TFE” may informally be used to denote polytetrafluoroethylene, Shortt explicitly states that “TFE” is being used to denote “tetrafluoroethylene” at col. 2, line 13. Tetrafluoroethylene has a boiling point of -76.3 °C which would appear to make it unsuited as a sheath in a process which is said to require exposure of a balloon contained within the sheath to temperatures of 93-180 °C. While the reference need not be enabling, it may only be relied upon for what it teaches, in this case, the sole material disclosed as suitable for the containment sheath of Shortt appears to disclose no more than the use of a gaseous containment sheath.

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Shortt (U.S. Patent No. 6,948,223) in view of Morales (U.S. Patent No. 5,920,975) and Hanson et al. (U.S. Patent No. 5,893,868), hereinafter Hanson, as applied to claim 9 above, and further in view of Euteneuer et al. (U.S. Patent No. 5,147,302), hereinafter Euteneuer. After careful review, Applicants must respectfully traverse this rejection.

For at least the reasons discussed above, claim 9 is believed to be patentable over the combination of Shortt, Morales, and Hanson. Euteneuer does not appear to remedy the shortcomings of those references with respect to claim 9. Therefore, independent claim 9 is believed to be patentable over the cited references. Since claim 12 depends therefrom and adds additional elements thereto, Applicants submit that claim 12 is also patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Claims 9 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shortt (U.S. Patent No. 6,948,223) in view of Morales (U.S. Patent No. 5,920,975) and Hanson et al. (U.S. Patent No. 5,893,868), hereinafter Hanson. After careful review, Applicants must respectfully traverse this rejection.

Turning to the second rejection, which the Final Office Action characterizes as based upon the improved method of Shortt rather than the prior art disclosure of Shortt, each of the deficiencies of the references as noted above appear to apply singly and in combination to the second rejection over Shortt in view of Morales and Hansen.

As discussed above, the cited combination does not appear to provide each and every element of the claimed method as is required to establish a *prima facie* rejection. Therefore, Applicants believe that claim 9 is patentable over Shortt in view of Morales and Hanson as applied to the method disclosure of Shortt. Since claim 18 depends therefrom and adds additional elements thereto, Applicants respectfully submit that claim 18 is also patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Claims 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shortt (U.S. Patent No. 6,948,223) in view of Morales (U.S. Patent No. 5,920,975)

and Hanson et al. (U.S. Patent No. 5,893,868), hereinafter Hanson, as applied to claim 9 above, and further in view of Miraki et al. (U.S. Patent No. 5,704,845), hereinafter Miraki. After careful review, Applicants must respectfully traverse this rejection.

For at least the reasons discussed above, claim 9 is believed to be patentable over the combination of Shortt, Morales, and Hanson. Miraki does not appear to remedy the shortcomings of those references with respect to claim 9. Therefore, independent claim 9 is believed to be patentable over the cited references. Since claims 10 and 11 depend therefrom and add additional elements thereto, Applicants submit that claims 10 and 11 are also patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Shortt (U.S. Patent No. 6,948,223) in view of Morales (U.S. Patent No. 5,920,975) and Hanson et al. (U.S. Patent No. 5,893,868), hereinafter Hanson, as applied to claim 9 above, and further in view of Johnson (WO 02/066095). After careful review, Applicants must respectfully traverse this rejection.

For at least the reasons discussed above, claim 9 is believed to be patentable over the combination of Shortt, Morales, and Hanson. Johnson does not appear to remedy the shortcomings of those references with respect to claim 9. Therefore, independent claim 9 is believed to be patentable over the cited references. Since claim 12 depends therefrom and adds additional elements thereto, Applicants submit that claim 12 is also patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Claims 14 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shortt (U.S. Patent No. 6,948,223) in view of Morales (U.S. Patent No. 5,920,975) and Hanson et al. (U.S. Patent No. 5,893,868), hereinafter Hanson, as applied to claim 9 above, and further in view of Motsenbocker et al. (U.S. Patent No. 6,629,350), hereinafter Motsenbocker. After careful review, Applicants must respectfully traverse this rejection.

For at least the reasons discussed above, claim 9 is believed to be patentable over the combination of Shortt, Morales, and Hanson. Motsenbocker does not appear to

remedy the shortcomings of those references with respect to claim 9. Therefore, independent claim 9 is believed to be patentable over the cited references. Since claims 14 and 15 depend therefrom and add additional elements thereto, Applicants submit that claims 14 and 15 are also patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Claims 16-17 and 19-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shortt (U.S. Patent No. 6,948,223) in view of Morales (U.S. Patent No. 5,920,975) and Hanson et al. (U.S. Patent No. 5,893,868), hereinafter Hanson, as applied to claim 9 above, and further in view of Jendersee et al. (U.S. Patent No. 5,836,965), hereinafter Jendersee. After careful review, Applicants must respectfully traverse this rejection.

For at least the reasons discussed above, claim 9 is believed to be patentable over the combination of Shortt, Morales, and Hanson. Jendersee does not appear to remedy the shortcomings of those references with respect to claim 9. Therefore, independent claim 9 is believed to be patentable over the cited references. Since claims 14 and 15 depend therefrom and add additional elements thereto, Applicants submit that claims 14 and 15 are also patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Conclusion

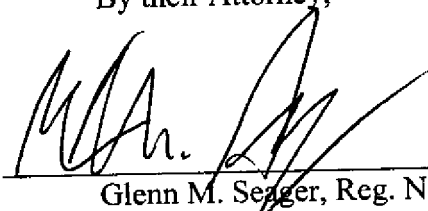
In view of the foregoing, all pending claims are believed to be in condition for allowance. Further examination, reconsideration, and withdrawal of the rejections are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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